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Lloyd W. Sadler or Daniel P. McCarthy  
Parsons Behle & Latimer  
201 South Main Street  
suite 1800  
Sail Lake, UT 84111-2218

EXAMINER

GART, MATTHEW S

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 11/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/633,050

Applicant(s)

ESPENES ET AL.

Examiner

Matthew s Gart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Oct. 15, 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/4/00 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

Applicant's election without traverse of claims 1-16 in Paper No. 5 is acknowledged.

#### ***Drawings***

This application has been filed with informal drawings, which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

#### **Claims 1-16 are rejected under 35 U.S.C. 112 Second Paragraph.**

Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites the limitation "Receiving product information." Claim 1 does not disclose who receives product information.

#### ***Claim Rejections - 35 USC §101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requires of this title.

**Claims 1-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

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The invention as recited in the claims is merely an abstract idea that is not within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter.

Mere recitation in the preamble (i.e., intended use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea. "The method of enhancing the process of e-commerce," mere nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not affect or effect the underlying process.

In the immediate application the applicant recites in the preamble, "A method for enhancing the process of e-commerce," but does not further disclose the use of any technology associated with the steps necessary to accomplish the desired process.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

**Claims 1-5, 7-14, and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Bezos U.S. Patent No. 6,029,141.**

Referring to claim 1. Bezos discloses a method equivalent to a method for enhancing the process of e-commerce, comprising the steps of:

- Receiving product information (at least abstract, "Following registration, the associate sets up a Web site to distribute hypertextual catalog documents that includes marketing information about selected products of the merchant.");
- Mapping said product information into product categories (at least claim 23 to claim 25);
- Assigning said product information into a template (at least Fig. 6 and column 11, lines 43-62);
- Populating said template with said product information (at least Fig. 6 and column 11, lines 43-62);
- Selecting a group of on-line marketplaces (at least column 1, line 50 to column 2, line 18);
- Broadcasting said populated template to said group of on-line marketplaces (at least column 1, line 50 to column 2, line 18);

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- Tracking activity on said broadcasted templates (at least column 13, lines 10-28);
- Communicating said activity to a client (at least column 16, lines 11-19); and
- Refining an on-line marketplace selection criteria (at least column 3, lines 26-41).

Referring to claim 2. Bezos further discloses a method comprising receiving and storing client information (at least Fig. 1 and Fig. 2).

Referring to claim 3. Bezos further discloses a method comprising sending e-mail communication to consumers (at least column 1, lines 50-61).

Referring to claim 4. Bezos further discloses a process comprising sending report information to clients (at least column 1, lines 50-61).

Referring to claim 5. Bezos further discloses a method wherein said receiving product information further comprises receiving description, price and quantity information (at least Fig. 8).

Referring to claim 7. Bezos further discloses a method wherein said assigning product information into a template further comprises dynamically modifying the content of said template based on the selected e-commerce marketplace site (at least column 5, lines 61-67).

Referring to claim 8. Bezos further discloses a method wherein said broadcasting further comprises sending a client product populated template to an on-line marketplace based on the results of prior e-commerce activity (at least column 5, lines 61-67).

Referring to claim 9. Bezos further discloses a method wherein said tracking activity further comprises collecting data on number of Web site hits, click-throughs, orders and e-mail communications (at least column 13, lines 10-28).

Referring to claim 10. Bezos further discloses a method wherein said communicating activity to a client further comprises analyzing said tracked activity, producing a report and sending said report to a client (at least Fig. 1, "Report Generation SW").

Referring to claim 11. Bezos further discloses a method wherein said refining an on-line marketplace selection criteria, further comprises analyzing said tracked activity, comparing said tracked activity with a clients objectives and modifying a marketplace filter function (at least APPENDIX B).

Referring to claim 12. Bezos further discloses a method comprising collecting sales information from e-commerce buyers (at least column 13, lines 10-28).

Referring to claim 13. Bezos further discloses a method wherein said collecting sales information from e-commerce buyers further comprises collecting credit card, product, price, address and quantity information (at least Fig. 1).

Referring to claim 14. Bezos further discloses a method comprising sending e-mail to customers (at least column 1, lines 50-61).

Referring to claim 16. Bezos further discloses a method wherein said product information further comprises information selected from the group consisting of information concerning goods, information concerning services, information concerning

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financial information, and information concerning information sources (at least column 8, lines 49-58).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 6 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bezos U.S. Patent No. 6,029,141, in view of Official Notice.**

Referring to claims 6 and 15. Bezos discloses a method according to claim 1 as indicated supra. Bezos does not expressly disclose a method wherein said mapping product information provides a mapping between client products and multiple e-commerce marketplace sites. Bezos does disclose a method wherein an individual or business entity can register as an associate, and can then set up a Web site to market customized subsets of their product in a particular area of expertise (at least column 3, lines 8-25). Examiner takes Office Notice that these particular areas of expertise are functionally equivalent to multiple e-commerce marketplace sites. For example, it would have been obvious to have provided Bezos to have substituted particular areas of expertise with multiple e-commerce marketplace sites in order to efficiently market and sell goods in cooperation with Web sites or other network sites of respective business partners (at least column 1, lines 50-60). Moreover, to have modified the method of Bezos to have included the multiple e-commerce marketplace site would have been



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obvious to the skilled artisan because the inclusion of such step would have been an obvious matter of design choice in light of the method already disclosed by Bezos. Such modification would not have otherwise affected the method Bezos and would have merely represented one of numerous steps that the skilled artisan would have found obvious for the purposes already disclosed by Bezos. Additionally, applicant has not persuasively demonstrated the criticality of providing this step versus the steps disclosed by Bezos.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Henrick et al., U.S. Patent No. 6,377,936, Apr. 23, 2002; discloses a method for performing targeted marketing over a large computer network.

Hill, U.S. Patent No. 5,970,471; discloses a virtual catalog and product presentation method and apparatus.

Kennedy et al., U.S. Patent No. 6,055,519, Apr. 25, 2000; discloses a framework for negotiation and tracking of sale of goods.

<http://www.targetedemail.com>; discloses a method of using targeted direct email to hit target markets.

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Any inquiry concerning this communication should be directed to Matthew Gart whose telephone number is 703-305-5355. This examiner can normally be reached Monday-Friday, 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



MSG

October 24, 2002

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WYNN W. COGGINS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600